

REMARKS/ARGUMENTS

Applicants have studied the Office Action dated September 3, 2008 and have made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-20 are pending. Claims 19 and 20 have been added. Claim 1 has been amended. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (3-6) rejected claims 1-8, 10, 12, 15-16, & 18 under 35 U.S.C. § 103(a) as being unpatentable over Ganser (U.S. Pat. No. 6,787,301) in view of James (U.S. Pat. No. 2,914,746); and
- (7) rejected claims 9, 11, 13, 14, & 17 under 35 U.S.C. § 103(a) as being unpatentable over Ganser (U.S. Pat. No. 6,787,301) in view of James (U.S. Pat. No. 2,914,746) and further in view of Titus (U.S. Pat. No.).

(3-6) Rejection under 35 U.S.C. §103(a) Ganser in view of James

As noted above, the Examiner rejected claims 1-8, 10, 12, 15-16, & 18 under 35 U.S.C. § 103(a) as being unpatentable over Ganser (U.S. Pat. No. 6,787,301) in view of James (U.S. Pat. No. 2,914,746).

Independent claim 1 has not been amended to distinguish the present invention over Ganser taken alone and/or in view of James. All of the limitations added to claim 1 came from original claim 1 itself. Claim 1 has been amended merely to more clearly recite the fact that more than one receptacle container is present, which was, perhaps, less clearly stated in the original language of claim 1 as "individual receptacle containers" (plural) "of the receptacle device." Therefore, no new matter has been added and the claim amendments do not limit the range of any permissible equivalents.

Other changes to claim 1 were grammatical corrections only and also do not surrender any equivalents.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Amended independent claim 1 recites, *inter alia*:

...

at least one holder that is designed for use in the laser microdissection system in such a way that it can hold a receptacle device **having a plurality of receptacle containers, each receptacle container** provided for receiving the biological object excised from the biological material...

identification means are provided for identifying the receptacle device held in each case by the holder by evaluating the coding of the holder, and control means are provided and are designed in such a way that, depending on the receptacle device identified in each case, they **provide selection functions specific to the receptacle device** for the allocation of individual biological objects to be excised from the biological material to **individual receptacle containers** of the receptacle device identified in each case.

(emphasis added)

The present invention provides a laser dissection system with a holder for holding a receptacle device with a plurality of receptacle containers. See FIGs. 2A & 2B and page 13, lines 24-26 of the instant application. The holder has a unique coding feature 22 that identifies the type of the receptacle device being held by the holder. Instant application, page 12, lines 11-20. Furthermore, the laser microdissection system has identification means for identifying the receptacle device by recognizing the coding feature of the holder. Control means are provided that, depending on the receptacle device identified in each case, provide selection functions specific to the receptacle device. As a result, individual biological objects excised from the biological material are allocated to individual ones of the plurality of receptacle containers of the receptacle device. *Id.* page 12, line 28 through page 13, line 22. These features are also present in claims 19 and 20.

The Ganser reference, in contrast, discloses a laser micro-dissection system, but **does not disclose a holder**. Ganser discloses only a single receptacle container in the

form of a so-called "collection vessel"¹ without ever disclosing a holder for a receptacle container or a corresponding receptacle device. See FIG. 2A, elements 20, 30, and 31 of the instant application. It follows then, that Ganser fails to disclose a receptacle device having a **plurality** of receptacle containers which can receive biological objects automatically by a control of a laser microdissection system irradiating objects with a laser beam of the laser microdissection system, as is present in the present invention and recited in the independent claims. See *also* Instant application, page 17, lines 9-19, claim 1.

The Examiner, on page 3 of the above-identified Office action, cites to col. 2, lines 57-67 and col. 3, lines 1-11 of Ganser for showing support of a holder. However, the "holder" disclosed in the sections identified by the Examiner is "a specimen holder," as opposed to "at least one holder that ...can hold a receptacle device having a plurality of receptacle containers, each receptacle container provided for receiving the biological object excised from the biological material," as recited in claims 1, 19, and 20 of the instant application. The holder of Ganser is the displaceable object carrier or X-Y stage. See Examiner's cited passages. It is clear from the language of the independent claims of the specification of the instant application that the displaceable X-Y stage of Ganser does not fulfill the features of the "holder" presently claimed. In short, Ganser fails to disclose any holder or any receptacle device with a plurality of receptacle containers.

The Examiner goes on to combine James with Ganser. However, James does not have any relation to a laser microdissection system, as is claimed in the instant application. For this reason alone, one of skill in the art would not look to James for modifying Ganser. Irrespective thereof, however, James only relates to a general identification system which can be part of an access control system that compares a coded identification card with a coded master card (see column 1, lines 15-22, in combination with column 13, lines 47-58, of James). Furthermore, James discloses

¹ Ganser references element 19 as a "collection vessel," but none of the Ganser figures show an element 19.

using a photoelectric, magnetic, inductive, capacitive coding of the identification card. However, similar to Ganser, James does not disclose any holder for a receptacle device of a laser microdissection system. This is because Ganser uses only a **single collection vessel**. James also fails to disclose a receptacle device having a **plurality** of receptacle containers. Therefore, no combination of James or Ganser derives "at least one holder that ... can hold a receptacle device having a plurality of receptacle containers, each receptacle container provided for receiving the biological object excised from the biological material," as recited in claims 1, 19, and 20 of the instant application.

Consequently, even if the teaching of Ganser were combined with the teaching of James (which, as stated above, would not be obvious to a skilled person acting in the field of laser microdissection systems), it would still never be obvious to a skilled person to transfer the teaching of James to the laser microdissection system known from Ganser in such a way that, depending on the coding of the receptacle device, corresponding selection functions specific to the identified receptacle device are automatically provided by the laser micro-dissection system in order to allow the allocation of individual biological objects to be excised from a biological material to the individual receptacle containers of the receptacle device identified in each case.

When there is no suggestion or teaching in the prior art, the suggestion can not come from the Applicants' own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation **in the prior art** to make the

selection made by the applicant”. Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). “Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination”. In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). “Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so.” ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). “Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be ‘**clear and particular.**’” Winner Int’l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applicants believe that there is no “clear and particular” teaching or suggestion in Ganser to incorporate the features of James and there is no teaching or suggestion in Ganser to incorporate the features of James

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the **applicant’s/appellant’s** disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), *cert. den.*, 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Ganser or James or to combine Ganser’s and James’ teachings to arrive at the claimed invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Ganser or James or from knowledge available to those skilled in the art.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

For the foregoing reasons, independent claim 1, as amended distinguishes over Ganser taken alone and/or in view of James. Claims 2-18 depend from independent claim 1. Since dependent claims contain all the limitations of the independent claims, claims 1-18 distinguish over Ganser taken alone and/or in view of James as well, and the Examiner's rejection should be withdrawn.

Claims 19 and 20 also distinguish over the combination of Ganser taken alone and/or in view of James as set forth herein.

(7) Rejection under 35 U.S.C. §103(a) Ganser in view of James and Titus

As noted above, the Examiner rejected claims 9, 11, 13, 14, & 17 under 35 U.S.C. § 103(a) as being unpatentable over Ganser (U.S. Pat. No. 6,787,301) in view of James (U.S. Pat. No. 2,914,746) and further in view of Titus (U.S. Pat. No.).

In the section above, entitled "(3-6) Rejection under 35 U.S.C. §103(a) Ganser in view of James", the deficiencies of the prior-art system disclosed in the Ganser and James references were discussed. Claims 9, 11, 13, 14, & 17 depend directly from newly amended claim 1, which distinguishes over Ganser in view of James. Since dependent claims contain all the limitations of the independent claims, claims 9, 11, 13, 14, & 17 distinguish over Ganser in view of James, as well.

Accordingly, the Applicants respectfully submit that it is not necessary at this stage to address the Titus reference as applied to claims 9, 11, 13, 14, & 17. Nor is it necessary

to address whether or not there is sufficient suggestion or motivation with a reasonable expectation of success for modifying the Ganser and James references, as required by MPEP § 2143. As such, Applicants respectfully request that the Examiner's rejection of claims 9, 11, 13, 14, & 17 be withdrawn.

CONCLUSION

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

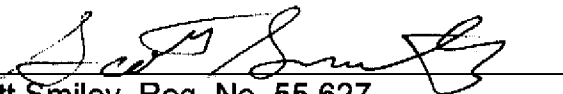
Petition for extension is herewith made. The extension fee for response within a period of 1 month pursuant to Section 1.136(a) in the amount of \$130.00 in accordance with Section 1.17 is enclosed herewith.

It is believed that no fee is due with this Amendment. However, if any fees are due with respect to Sections 1.16 or 1.17, please charge to the deposit account of the undersigned firm, Acct. No. 503,836.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

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